

Attorney Docket No. 740756-2703
Application No. 10/760,294
Page 2

REMARKS

The Examiner's Office Action of November 3, 2004 has been received and its contents reviewed. Applicant would like to thank the Examiner for reviewing and considering this application.

Claims 1-16 are pending for consideration, of which claims 1, 5, 9 and 13 are independent.

Turning now to the detailed Office Action, claims 1-16 stand rejected under the judicially created doctrine of obviousness-type double patenting as unpatentable over claims 12-20 U.S. Patent No. 5,581,102 (hereafter the '102 patent).

In the sole rejection, the Examiner contends that claim 12 of the '102 patent is either a narrower version of the claims of the present application or an obvious variant thereof. The Examiner asserted that the phrase "wherein the thickness of the semiconductor layer in the source and drain region is made less than the thickness of the semiconductor layer in the channel forming region by the etching step" in claim 12 of the '102 patent has no different meaning than Applicant's claimed feature of "...the semiconductor island has a protrusion and edges of the gate electrode, the gate insulating film and the protrusion are substantially aligned with each other".

In response, while Applicant appreciates that claim 12 of the '102 patent is directed to an etching process for forming a gate electrode, a gate insulating layer and a protrusion portion of a semiconductor layer, the '102 patent does not disclose or suggest that the edges of the gate electrode, the gate insulating film and the protrusions are substantially aligned with each other by the etching process.

Applicant respectfully submits that claim 12 of the '102 patent does not recite any relationship between the edges of the gate electrode, the gate insulating film and the protrusion, and that the relationship between the source and drain regions and the protrusion of claim 12 of the '102 patent does not indicate any relationship between the gate electrode, the gate insulating film and the protrusion.

As noted in MPEP §804, the burden is on the Office to establish why one of ordinary skill in the art would conclude that the invention recited in the instant claims 1-16 is an obvious variant of the invention recited in claims 12-20 of the '102 patent. That is, there must be a suggestion or teaching in the prior art that would motivate one of ordinary skill in the art to modify the invention recited in the claims 12-20 of the '102 patent to reach the invention recited in the instant claims 1-16. Applicant respectfully submits that the capability

BEST AVAILABLE COPY

Attorney Docket No. '40756-2703

Application No. 10/760,294

Page 3

and knowledge of one of ordinary skill does not provide motivation or suggestion to modify the claims of the '102 patent. Therefore, it is respectfully asserted that the Office has not yet provided such suggestion or teaching. Accordingly, the rejection should be withdrawn.

While the present application is now believed to be in condition for allowance, should the Examiner find some issue to remain unresolved, or should any new issues arise, which could be eliminated through discussions with Applicant's representative, then the Examiner is invited to contact the undersigned by telephone in order that the further prosecution of this application can thereby be expedited.

Respectfully submitted,



Luan C. Do
Registration No. 38,434

NIXON PEABODY LLP
Suite 900, 401 9th Street, N.W.
Washington, D.C. 20004-2128
(202) 585-8000
JLC/LCD

**This Page is Inserted by IFW Indexing and Scanning
Operations and is not part of the Official Record**

BEST AVAILABLE IMAGES

Defective images within this document are accurate representations of the original documents submitted by the applicant.

Defects in the images include but are not limited to the items checked:

- ☐ BLACK BORDERS
- ☐ IMAGE CUT OFF AT TOP, BOTTOM OR SIDES
- ☐ FADED TEXT OR DRAWING
- ☐ BLURRED OR ILLEGIBLE TEXT OR DRAWING
- ☐ SKEWED/SLANTED IMAGES
- ☐ COLOR OR BLACK AND WHITE PHOTOGRAPHS
- ☐ GRAY SCALE DOCUMENTS
- ☒ LINES OR MARKS ON ORIGINAL DOCUMENT
- ☒ REFERENCE(S) OR EXHIBIT(S) SUBMITTED ARE POOR QUALITY
- ☐ OTHER: _____

IMAGES ARE BEST AVAILABLE COPY.

As rescanning these documents will not correct the image problems checked, please do not report these problems to the IFW Image Problem Mailbox.